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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/628,324

07/29/2003

Joh-E Ikeda

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6188

513 7590 03/09/2007
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WASHINGTON, DC 20006-1021

EXAMINER

AEDER, SEAN E

ART UNIT

PAPER NUMBER

1642

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/628,324	Applicant(s) IKEDA ET AL.	
	Examiner Sean E. Aeder, Ph.D.	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) 38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23 and 34-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/31/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

The Amendments and Remarks filed 12/8/06 in response to the Office Action of 8/8/06 are acknowledged and have been entered.

Claims 34-39 have been newly added by Applicant.

Claims 23 and 34-39 are pending.

Claim 23 has been amended by Applicant.

Claims 38-39 are withdrawn from further consideration by the examiner under 37 CFR 1.142(b) as being drawn to a non-elected invention. Claims 38-39 are drawn to methods of making the elected product. It is noted that claims 38-39 may be rejoined upon allowance of the elected product claims.

Claims 23 and 34-37 are currently under examination.

The text of those sections of Title 35 U.S.C. code not included in this Office Action can be found in a prior Office Action.

The following Office Action contains NEW GROUNDS of rejections necessitated by amendments.

Objections and Rejections Withdrawn

All outstanding objections and rejections have been withdrawn.

New Rejections Necessitated by Amendments

35 USC § 112, first paragraph (New Matter Rejection)

Claims 23 and 34-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a **NEW MATTER** rejection.

Claim 23 and dependent claims 34-35 are rejected because claim 23 recites: "An isolated antibody that specifically binds to a polypeptide consisting of the amino acid sequence of SEQ ID NO:3 *but not* to a polypeptide consisting of the amino acid sequence of SEQ ID NO:1". Descriptions of antibodies that bind to a polypeptide consisting of the amino acid sequence of SEQ ID NO:3 *but not* to a polypeptide consisting of the amino acid sequence of SEQ ID NO:1 are not found in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the invention was filed, had possession of the claimed invention.

Claim 34 and dependent claim 35 are rejected because claim 34 recites: "...wherein the antibody specifically binds to a C-terminal amino acid sequence of a polypeptide consisting of the amino acid sequence of SEQ ID NO:3". Descriptions of antibodies that specifically bind to a C-terminal amino acid sequence of a polypeptide

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consisting of the amino acid sequence of SEQ ID NO:3 are not found in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the invention was filed, had possession of the claimed invention.

Claim 35 is rejected for reciting: "The antibody of claim 34, wherein the C-terminal amino acid sequence consists of five or more contiguous amino acids at positions 1283-1295 of the polypeptide consisting of the amino acid sequence of SEQ ID NO:3". Descriptions of antibodies wherein the C-terminal amino acid sequence consists of five or more contiguous amino acids at positions 1283-1295 of the polypeptide consisting of the amino acid sequence of SEQ ID NO:3 are not found in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the invention was filed, had possession of the claimed invention.

Claim 36 and dependent claim 37 are rejected because claim 36 recites: "An isolated antibody which specifically binds to a C-terminal amino acid sequence of a polypeptide consisting of the amino acid sequence of SEQ ID NO:3". Descriptions of isolated antibodies which specifically binds to a C-terminal amino acid sequence of a polypeptide consisting of the amino acid sequence of SEQ ID NO:3 are not found in the specification in such a way as to reasonably convey to one skilled in the relevant art that

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the inventors, at the time the invention was filed, had possession of the claimed invention.

Claim 37 is rejected for reciting: "The antibody of claim 36, wherein the C-terminal amino acid sequence consists of five or more contiguous amino acids at positions 1283 to 1295 of the polypeptide consisting of the amino acid sequence of SEQ ID NO:3". Descriptions of antibodies wherein the C-terminal amino acid sequence consists of five or more contiguous amino acids at positions 1283 to 1295 of the polypeptide consisting of the amino acid sequence of SEQ ID NO:3 are not found in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the invention was filed, had possession of the claimed invention.

Summary

No claim is allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is


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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E. Aeder, Ph.D. whose telephone number is 571-272-8787. The examiner can normally be reached on M-F: 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on 571-272-0898. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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